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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,049	07/25/2001	Andreas Dieberger	YOR9-2001-0385 (8728-520)	6021
46069 7590 06/10/2010 F. CHAU & ASSOCIATES, LLC Frank Chau 130 WOODBURY ROAD WOODBURY, NY 11797			EXAMINER VAN BRAMER, JOHN W	
			ART UNIT 3622	PAPER NUMBER
			NOTIFICATION DATE 06/10/2010	DELIVERY MODE ELECTRONIC

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/915,049
Filing Date: July 25, 2001
Appellant(s): DIEBERGER ET AL.

Nathaniel T. Wallace
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 8, 2010 appealing from the Office action mailed July 1, 2009.

(1) Real Party in Interest

- The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

- The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

- The following is a list of claims that are rejected and pending in the application: Claims 1-6, 8-16, and 18-20 are pending and stand rejected under 35 U.S.C. 103(a) as being unpatentable over Boyd (U.S. Patent Number: 6,484,148)

(4) Status of Amendments After Final

- The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

- The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

- The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified

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by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

- The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

- 6484148 Boyd 11-2002

(9) Grounds of Rejection

- The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 8-16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyd (U.S. Patent Number: 6,484,148).

Claim 1: Boyd discloses a computer readable medium embodying instructions executable by a processor to perform a method for displaying content on a display device:

- a. Retrieving a plurality of rules, each rule associated with controlling the display of content, wherein the content is provided by a content provider. (Col 9, lines 25-67; and Col 13, lines 22-37)
- b. Updating a plurality of device parameters, wherein at least one device parameter is updated in response to detecting of one of a radio frequency identification tag and an infrared tag. (Col 6, lines 16-21; Col 7, lines 25-57; Col 8, lines 23-65) (EZ Pass transponders are radio frequency identification tags)
- c. Triggering at least two rules of the plurality of rules satisfied by the plurality of device parameters. (Col 7, lines 25-57; Col 8, lines 23-65)
- d. Executing the at least two satisfied rules in response to the detection of the radio frequency identification tag or the infrared tag be detected. (Col 7, lines 25-57; Col 8, lines 23-65; and Col 10, 11-14)
- e. Displaying a first portion of the content according to a first satisfied rule of the two triggered rules. (Col 7, lines 25-57; Col 8, lines 23-65)
- e. Preventing the display of a second portion of the content according to a second rule of the two triggered rules, wherein the second rule overrides all other rules for the display of the second portion of the content. (Col 9, lines 25-67; and Col 13, lines 22-37. According to the

triggering step it is only necessary to trigger two rules. The first rule is associated with the first portion of content and display occurs in the display step. The second rule prevents the display of the second portion of content. Thus, the wherein clause which indicates that the second rule overrides any all other rules is non-limiting because there are no additional rules required, and thus no further rules to be overridden.)

- f. Determining a fee according to the first rule of the triggered rules, wherein the content provider is charged a fee. (Col 7, lines 25-57; Col 8, lines 23-65)

While Boyd does not specifically state that the preventing of the displayed of a second portion of the content is done in accordance with a second satisfied rule he does state that the system allows advertiser's to place conditions on when an ad is displayed in Col 13, lines 22-28. The specific rules he provides for examples are positive rules such as display the advertisement if the customer is a male, at least 35 years old, has an income greater than \$80,000, and it is during the winter months.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made that any positive rule can also be written as a negative rule in order to achieve the same results. An advertiser could target the same individuals by creating the rule in negative form such as do not display the advertisement is the customer is not a male,

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younger than 35 years old, has an income less than \$80,000.01, and it is not winter. The rationale for writing rules in such a manner is that Boyd allows the advertisers to place the conditions and there are a limited number of predictable ways in which an advertiser can create conditional rules. They can create positive rules, negative rules, or combination of positive and negative rules. The decision as to whether an advertiser places the condition in a positive form or a negative form is a matter of design choice on the part of the advertiser creating the rule.

Claim 2: Boyd discloses the method of claim 1, wherein at least one rule is defined by the content provider to dynamically control the display of the content according to the device parameters. (Col 8, lines 23-65)

Claim 3: Boyd discloses the method of claim 1, wherein the step of executing the at least one triggered rule further comprises the step of receiving a rule trigger from one of a location handler and a signal handler. (Col 7, lines 25-57; Col 8, lines 23-65)

Claim 4: Boyd discloses the method of claim 3, wherein the step of receiving a rule trigger from the location handler further comprises the step of updating a positional parameter. (Col 12, lines 14-40; and Col 13, lines 29-37)

Claim 5: Boyd discloses the method of claim 3, wherein the step of receiving a rule trigger from the signal handler further comprises the steps of:

- a. Interpreting an input signal (Col 6, lines 35-58)
- b. Generating a programmatic event flag (Col 6, lines 35-58)

Claim 6: Boyd discloses the method of claim 5, wherein the step of generating a programmatic event flag further comprises the step of generating one of a reply signal and the rule trigger. (Col 6, lines 35-58)

Claim 8: Boyd discloses the method of claim 1, wherein the step of determining a fee further comprises the steps of:

- a. Determining a value for each of the device parameters (Col 8, lines 23-65)
- b. Determining at least one device parameter satisfying the triggered rule (Col 8, lines 23-65)
- c. Determining the fee according to value of the device parameters satisfying the triggered rule. (Col 8, lines 23-65)

Claim 9: Boyd discloses the method of claim 8, further comprising the step of charging the fee to a client providing content to be displayed. (Col 8, lines 23-65)

Claims 10 and 11: Boyd discloses the method of claim 8, further comprising the step of apportioning fees (Col 8, lines 23-65). However, Boyd is silent with regard to various permutations in which fee apportionment might entail. The teachings of Boyd describe the display system itself and not who owns and operates the display system. It would have been obvious to one of ordinary skill in the art at the time of the invention that the service provider (entity that runs, operates and/or owns the display device) would need to reimburse the third party carrier (i.e. taxi company, billboard owners, etc) for allowing them to put the display on the carrier's physical property (i.e. taxi cabs, etc.). One would have been motivated to institute such a reimbursement in order to provide the third party carrier with an incentive to install the display to help in the defrayment of operating costs.

Claim 12: Boyd discloses the method of claim 8, further comprising the step of apportioning the fees (Col 8, lines 23-65). However, Boyd is silent with regard to various permutations in which fee apportionment might entail. The teachings of Boyd describe the display system itself and not

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who owns and operates the display system. It would have been obvious to one of ordinary skill in the art at the time the invention was made that when the device is sold as a stand alone device, in which various third party carriers (i.e. taxi companies, billboard owners, etc.) can purchase and install, a fee would need to be paid to the plurality of owners, by the service provider (entity that operates the advertisement distribution hardware), in order to be provided the opportunity to display advertisements on their mobile display unit. One would have been motivated to provide such a reimbursement in order to maximize the number of display units on which it can provide advertisements, and as a result maximize the fees it charges to entities wishing to advertise on the service.

Claim 13: Boyd discloses the method of claim 1, wherein the fee is charged to a user for the use of the display. (the user is the advertiser using the service) (Col 8, lines 23-65)

Claim 14: Boyd discloses a computer readable medium embodying instructions executable by a processor to perform a method for displaying content on a mobile display device:

- a. Retrieving a plurality of rules stored in the mobile display device from a rule server. (Col 9, lines 43-63; and Col 13, lines 22-37)

- b. Determining a value for each of a plurality of device parameters. (Col 6, lines 16-21; Col 7, lines 25-57; Col 8, lines 23-65)
- c. Executing each rule satisfied by the device parameters, wherein the execution is in response to detecting at least one of a radio frequency tag and an infrared tag. (Col 6, lines 16-21; Col 7, lines 25-57; Col 8, lines 23-65) (EZ Pass transponders are radio frequency identification tags)
- e. Displaying content according to each satisfied rule, wherein a first satisfied rule specifies that the radio frequency identification tag or the infrared tag be detected and a second satisfied rule specifies a certain demographic determined based upon a product associated with the radio frequency identification tag or the infrared tag. (Col 6, lines 16-21; Col 7, lines 25-57; Col 8, lines 23-65) (EZ Pass transponders are radio frequency identification tags)
- f. Determining a monetary charge based on the content displayed and a combination of values associated with each of the satisfied rules, which triggered the display of the content, wherein different rules having different values. (Col 6, lines 16-21; Col 7, lines 25-57; Col 8, lines 23-65)

While Boyd does not specifically state that the monetary charge that is determined is variable, he does disclose that the ranking function that determines which advertisement to display can be based the advertising

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fees generated by displaying the advertisement and/or the strength of match between the advertisement profile and the customer profile in Col 8, lines 46-51. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include variable monetary charges based upon how strong the match is between the advertisement profile and the customer profile. The rational for including variable monetary charges is that common sense dictates the for delivering more narrowly targeted advertisements would greater than the fee for delivering broadly targeted advertisement and in order for Boyd to rank based upon the advertising fees, there must be some variability in the fees charged for the various advertisements. Without such variability the fees would be the same for all advertisements and ranking based on fees would not be possible.

Claim 15: Boyd discloses the method of claim 14, wherein at least one rule is defined by a content provider to dynamically control the display of the content according to the device parameters. (Col 8, lines 23-65)

Claim 16: Boyd discloses the method of claim 14, further comprising receiving a rule trigger from a location handler and updating the positional parameter upon receiving the rule trigger from the location handler. (Col 7,

lines 25-57; Col 8, lines 23-65; Col 12, lines 14-40; and Col 13, lines 29-37)

Claim 18: Boyd discloses the method of claim 14, further comprising:

- a. Receiving a rule trigger from a signal handler . (Col 7, lines 25-57; Col 8, lines 23-65; and Col 9, lines 26-63)
- b. Interpreting an input signal. (Col 6, lines 35-58)
- c. Generating a programmatic event flag upon receiving a rule trigger from the signal handler. (Col 6, lines 35-58)

Claim 19: Boyd discloses the method of claim 18, wherein the step of generating a programmatic event flag further comprises the step of generating a reply signal. (Col 6, lines 35-58; and Col 13, lines 5-67)

Claim 20: Boyd discloses a program storage device readable by machine, tangibly embodying a program of instructions executable by the machine to perform method steps for displaying content on a display device, the method steps comprising:

- a. Retrieving a plurality of rules for the display of content, wherein the content is provided by a content provider. (Col 9, lines 43-63; and Col 13, lines 22-37)

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- b. Updating a plurality of device parameters, wherein at least one device parameter is updated in response to detecting of one of a radio frequency identification tag and an infrared tag provided to at least one spectator. (Col 6, lines 16-21; Col 7, lines 25-57; Col 8, lines 23-65)
(EZ Pass transponders are radio frequency identification tags)
- c. Determining a rule trigger for triggering at least one rule of the plurality of rules according to the plurality of device parameters. (Col 6, lines 16-21; Col 7, lines 25-57; Col 8, lines 23-65)
- d. Executing a trigger rule for causing the display of the content on the display device, wherein the triggered rule specifies that the spectator be detected, wherein the spectator is detected by a receiver which detects the radio frequency identification tag or the infrared tag provided to the spectator. (Col 6, lines 16-21; Col 7, lines 25-57; Col 8, lines 23-65) (EZ Pass transponders are radio frequency identification tags)
- e. Determining a fee according to at least one device parameter upon executing a rule for the display of content, wherein the content provider is charged the fee (Col 6, lines 16-21; Col 7, lines 25-57; Col 8, lines 23-65), wherein the method step of determining a fee further comprises:
 - i. Determining a value for each of the device parameters. (Col 8, lines 23-65)

- ii. Determining at least one device parameter satisfying the triggered rule. (Col 8, lines 23-65)
- iii. Determining the variable fee dynamically for each display of the content according to a combined value of the device parameters currently satisfying the triggered rule. (Col 8, lines 23-65)

While Boyd does not specifically state that the monetary charge that is determined is variable, he does disclose that the ranking function that determines which advertisement to display can be based the advertising fees generated by displaying the advertisement and/or the strength of match between the advertisement profile and the customer profile in Col 8, lines 46-51. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include variable monetary charges based upon how strong the match is between the advertisement profile and the customer profile. The rational for including variable monetary charges is that common sense dictates the for delivering more narrowly targeted advertisements would greater than the fee for delivering broadly targeted advertisement and in order for Boyd to rank based upon the advertising fees, there must be some variability in the fees charged for the various advertisements. Without such variability the fees would be the same for all advertisements and ranking based on fees would not be possible.

(10) Response to Argument

- The appellant argues, regarding claim 1, that Boyd does not teach preventing the display of a second portion of the content according to a second satisfied rule of the two triggered rules. As a first matter of note, the applicant has not argued the validity of the 35 USC 103 rejection. No arguments have been put forth to indicate why the proposed obviousness rejection is incorrect. The applicant has argued the claim as if a 35 USC 102 rejection has been applied. The examiner has already agreed that the Boyd reference does not specifically disclose the use of negative rules supplied by advertisers. However, the appellant claims make the assumption that advertisers will submit rules that are negative, and thus satisfying the negative rule prevents the display of the advertisement. The applicant claims retrieving a plurality of rules that control the display of content (advertising), updating device parameters in response to detecting one of a radio frequency tag and an infrared tag, triggering at least two rules (which by the examiners interpretation of Boyd is that two different advertising opportunities have presented themselves in response to a user accessing a web page), executing the at least two rules, and displaying the first portion of the content (the first advertisement) according to a first satisfied rule, preventing the display of a second portion of the content (the second advertisement) according to a second satisfied rule, And determining a fee according to the first rule that was triggered (the display

of the first advertisement). Thus the applicant is assuming that some of the rules when satisfied will cause an advertisement to be displayed, and some of the rules when satisfied will prevent the display of an advertisement. While Boyd discloses retrieving rule supplied by advertisers and applying the rules to determine which advertisements to display, he does not specifically state that the satisfaction of a rule prevents the display of the advertisement (Boyd: Col 7, lines 25-57; Col 8, lines 23-65; and Col 10, 11-14; Col 9, lines 25-67; and Col 13, lines 22-37). The system in Boyd allows advertiser's to place conditions on when an ad is displayed in Col 13, lines 22-28. However, all of the examples of advertiser rules in Boyd are written in a positive form. The specific rules he provides for examples are positive rules such as display the advertisement if the customer is a male, at least 35 years old, has an income greater than \$80,000, and it is during the winter months. However, the scope of claimed appellants claimed invention does not include the way in which the rules are created and or crafted. This is true for Boyd as well. Thus, whether an advertiser chooses to create rules that are positive in form or negative in form is entirely up to the advertiser and outside the scope of both inventions. Whether an advertiser chooses to write a rule in a positive form such as display ads to a customer that is a male, at least 35 years old, has an income greater than \$80,000, and it is during the winter months thus resulting in the display of the advertisement

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when these criteria are met, or whether an advertiser elects to write the rule in a negative fashion such as do not display ads during the winter, spring, summer or fall thus resulting in display of the advertisement only during the winter months, or even a combination of positive and negative rules such as display ad to a customer that is a male, at least 35 years old, has an income greater than \$80,000 but not during the summer months is entirely up to the advertiser submitting the rules. The scope of the applicants claim does not provide control over the advertiser choice in the creation of a rule. The applicants claims make an assumption that an advertiser will submit a rule that when satisfied can result in the prevention of the display of the ad (content). As such, when such a rule is triggered, the ad is not displayed. The prior art discloses the ability of the advertiser to craft their own rules, as such when an advertiser crafts a rule in a fashion that results in the prevention of the ad from being displayed, the limitations of the claim as currently written have been met.

- The appellant argues, regarding claim 14, that Boyd does not teach determining a variable monetary charge based on the content displayed and a combination of values associated with each of the satisfied rules which triggered the display of the content, wherein different rules having different values. As a first matter of note, the applicant has not argued the validity of the 35 USC 103 rejection. No arguments have been put forth to indicate why the proposed obviousness rejection is incorrect. The

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applicant has argued the claim as if a 35 USC 102 rejection has been applied. The examiner has already agreed that the Boyd reference does not specifically disclose that the monetary charge that is determined is variable. However, Boyd does disclose that the ranking function that determines which advertisement to display can be based the advertising fees generated by displaying the advertisement and/or the strength of match between the advertisement profile and the customer profile in Col 8, lines 46-51. Thus, an advertisement must be selected based upon a fee for the presentation of the advertisement, the strength of the match between the advertisers target market and the profile of the customer, or a combination of a fee and the strength of a match between the advertisers target market and the customer profile. The examiner's 103 rejection is based upon the combination between the fee and the strength of match. Advertisers will typically pay a higher rate for more narrowly targeted advertisers. If an advertiser wishes to target an audience that is male, over 35, and with an income greater than \$80,000, then they will pay the highest rate for the presentation of an advertisement that meets all of these criteria. However, if the advertising opportunity is for a customer that is male, over 35, but the income is either unknown or less than \$80,000 then only two thirds of the advertisers criteria has been met, and the advertiser may be willing to have the advertisement delivered, but will typically not desire to pay the full amount due to the fact that the strength

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of match is not 100%. In order for Boyd to rank based upon the advertising fees, there must be some variability in the fees charged for the various advertisements in association with the strength of the match.

Without such variability the fees would be the same for all advertisements and ranking based on fees and/or fees and strength of match would not be possible since the variation would only be a result of the strength of match.

- The appellant argues, regarding claim 20, that Boyd fails to teach or suggest determining the variable fee dynamically for each display of the content according to a combined value of the device parameters currently satisfying the triggered rule. As a first matter of note, the applicant has not argued the validity of the 35 USC 103 rejection. No arguments have been put forth to indicate why the proposed obviousness rejection is incorrect. The applicant has argued the claim as if a 35 USC 102 rejection has been applied. The examiner has already agreed that the Boyd reference does not specifically disclose that the monetary charge that is determined is variable. However, Boyd does disclose that the ranking function that determines which advertisement to display can be based the advertising fees generated by displaying the advertisement and/or the strength of match between the advertisement profile and the customer profile in Col 8, lines 46-51. It is clear that the decision is made in a dynamic fashion because the decision is based upon the customer profile of current

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advertising opportunity and the ranking of the fees and the strength of match between the advertiser profile and the current viewing opportunity. Thus, the decision must be made when the opportunity presents itself and not at any time before the viewing opportunity occurs and as such results in a dynamic decision. The arguments directed towards the "variable fee" have been addressed above, but have been reiterated below for convenience. Boyd discloses in Col 8, lines 46-51 that an advertisement must be selected based upon a fee for the presentation of the advertisement, the strength of the match between the advertisers target market and the profile of the customer, or a combination of a fee and the strength of a match between the advertisers target market and the customer profile. The examiner's 103 rejection is based upon the combination between the fee and the strength of match. Advertisers will typically pay a higher rate for more narrowly targeted advertisers. If an advertiser wishes to target an audience that is male, over 35, and with an income greater than \$80,000, then they will pay the highest rate for the presentation of an advertisement that meets all of these criteria. However, if the advertising opportunity is for a customer that is male, over 35, but the income is either unknown or less than \$80,000 then only two thirds of the advertisers criteria has been met, and the advertiser may be willing to have the advertisement delivered, but will typically not desire to pay the full amount due to the fact that the strength of match is not 100%. In order

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for Boyd to rank based upon the advertising fees, there must be some variability in the fees charged for the various advertisements in association with the strength of the match. Without such variability the fees would be the same for all advertisements and ranking based on fees and/or fees and strength of match would not be possible since the variation would only be a result of the strength of match.

(11) Related Proceeding(s) Appendix

- No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/John Van Bramer/
John Van Bramer
Primary Examiner, Art Unit 3622

Conferees:

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